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| 10/003,697 | 10/31/2001 | Frank J. Kronzer | 11301-0222 (44039-264309) | 2526 |

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09/25/2003

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,697

Applicant(s)

KRONZER, FRANK J.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

This Office Action is responsive to the amendment filed 6-30-03.

Double Patenting

1. Claims 1-30 of this application conflict with claims 1-32 of Application No. 10/003,698. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of copending Application No. 10/003,698. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-18, 21-26, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,232,267 to Oshima et al.

6. Oshima teaches a thermal transfer sheet comprising a substrate of polypropylene, polyester films and processed paper (cellulosic nonwoven) (claims 12, 13, 17, 22, 26), a release coating layer, a white layer which may comprise a resin binder of fluoro carbon, melamine, polyurethane or silicone resins (cross-linkable binder) and an adhesive (opaque crosslinked polymer layer and/or discontinuous polymer layer having an opacifying material), a peeling film layer and a dye layer (discontinuous printable layer) adjacent to the adhesive layer. The peeling layer may also contain the white pigment (opacifying white pigment) (col. 5, lines 50-55). See col. 6, lines 1-35 and col. 8, lines 1-20. At col. 8, line 33, Oshima teaches cross-linking any of the aforementioned resins, and further describes how the white layer may include PMMA, cellulosic derivatives, an acrylic resin, an epoxy (cross-linking agent), an ethylene/acrylic acid copolymer and any copolymer combined materials of two or more (meeting claims 2-3, 5-7, 18, 21). See col. 8, lines 35-55 and Figures 1 and 2.

At col. 9, lines 33-65, Oshima teaches the peeling layer comprises polyethylene wax (claims 9, 14, 23).

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Oshima teaches a receptor layer comprising a release layer. At col. 12, lines 1-15, Oshima teaches adding an additive such as a release agent like an epoxy or silicon modified agent, a reaction-curable silicon compound (curing agent). At col. 12, lines 25-40, a release layer also comprises a urethane or PVA resin. At col. 9, lines 50-68, a releasing agent such as a fluorocarbon resin, silicone wax, and a surfactant are included. Also acrylic or any combinations of polymers are taught at col. 10, lines 1-9. Claims 10, 11, 15, 16, 24 and 25 are met.

Processes for transferring the sheet of Oshima is taught at col. 10, lines 10-20 and in Example 1, Comparative Example 2, and col. 16. Also the substrate may be coated on either side with a polymer or coating liquid. See also col. 7, lines 1-45. Claims 28-30 are met.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 10, 19-21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,232,267 to Oshima et al. in view of USPN 5,508,105 to Orensteen et al.

9. Oshima essentially teaches the claimed invention above. Oshima does not teach adding aziridine. However, Orensteen teaches a thermal print receptive and retroreflective sheeting where he teaches adding crosslinker aziridine (multifunctional aziridine) increases weatherability and chemical resistance, improves the tendency of a top layer to lie flat and low curing temperatures in such a multi-function layer. Hence it would have been obvious to one of ordinary skill in the art to modify the sheet of Oshima to further include aziridine in any layer

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since Orensteen teaches adding it provides many functions as taught above. See col. 9, lines 12-35.

Response to Arguments

1. Applicant's arguments filed 6-30-03 have been fully considered but they are not persuasive.
2. Applicant believes the double patenting rejection over claims 1-30 are not identical to claims 1-32 of copending Application No. 10/003,698, as the inventions are drawn to different layers. The Applicant has not persuasively argued. It is an unassailable fact that the claims are identical. The same, identical subject matter is very well claimed. All claims are to the heat transfer material comprising the same matter. See the instant claims. Therefore, claims 1-30 are still provisionally rejected.
3. Applicant alleges the claim objection over claims 1 and 22 are not a substantial duplicate of each other. The Applicant has not persuasively argued. Both claims contain the language "comprising" and may in fact contain other ingredients.
4. Applicant further alleges Oshima does not teach cross-linked polymers nor the purpose of the design. The Examiner does not agree. Oshima very well teaches the same cross-linked polymers. The Applicant claims cross-linking agents such as epoxy resins and Oshima teaches epoxy resins. The same resins are disclosed in Oshima. See col. 6, lines 1-45 and col. 12, lines 1-15. A skilled polymer chemist knows when the same resins are used, the same end product is the result (cross-linked polymer), and furthermore, graft polymers of Oshima provide some degree of cross-linking. In regards to the purpose of the design, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the

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prior art cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

5. Applicant appears to continue to argue the location of the layers. However, Applicant does not claim any structural limitations. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the location of the peelable layer) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant contests the peelable layer as claimed is an adhesive layer. The peelable layer as claimed is contained in the Oshima reference. Furthermore, an adhesive layer is not claimed.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an adhesive layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant again relies upon features that are not claimed. Applicant states the white layer of Oshima is thinner than the applicants, the thickness is not claimed. Applicant states the print and peelable layers are also very thin, the print and peelable thickness are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the thickness of the white layer, print and peelable layers) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. In response to applicants argument that Orensteen simply teaches the use of aziridine, Orensteen teaches adding aziridine for the purpose of increasing weatherability and chemical resistance, improving the tendency of a top layer to lie flat and curing temperatures. Applicant uses aziridine in the same manner. The request to withdraw the 103 rejection is denied.

10. Regarding instant claims 19-20 and 27 directed to aziridine and modifications of aziridine which were not rejected under the prior art, the Applicant believes they should now be allowable. The claims were erroneously not included, but are now as part of the 103 rejection. However, the claims are still rejected under USC 101 and cannot be found allowable.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

September 11, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

